

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

BERNARD KUCINSKI et al.

Serial No. **10/765,749**

Filing Date: **1/27/2004**

For: **METHOD FOR SCORING AND
DELIVERING TO A READER TEST
ANSWER IMAGES FOR
OPEN-ENDED QUESTIONS**

Examiner: **Chanda L. Harris**

Art Unit: **3714**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Sir:

SECOND SUPPLEMENTAL APPEAL BRIEF PURSUANT TO 37 CFR §41.37

Pursuant to 37 CFR §41.37, and to the filing of a Notice of Appeal on August 2, 2005, and to the issuance of a Notice of Panel Decision from Pre-Appeal Brief Review dated October 6, 2005, and to the issuance of a Notification of Non-Compliant Appeal Brief on July 10, 2006, and to the issuance of a Notification of Non-Compliant Appeal Brief on November 29, 2007, Applicant/Appellant hereby appeals to the Board of Patent Appeals and Interferences from the Examiner's Decision dated May 4, 2005, finally rejecting under 35 USC §102(e) Claims 1-8, 13, 14, and 17-24; and under 35 USC §103(a) Claims 9-12, 15, and 16. Claims 1-16 are drawn to a method scoring an answer page containing an answer to an open-ended question; Claims 17-25, to a method for delivering an answer page containing an answer to an open-ended question to a reader for scoring. A copy of the claims in the case is attached as Appendix A, and an Evidence appendix as Appendix B. The fee for filing this Brief in support of an appeal pursuant to 37 CFR §1.17(c) was

enclosed with the original Appeal Brief. The Commissioner is authorized to charge or credit any discrepancies in fee amounts to Deposit Account No. 01-0484.

I. **Real Party in Interest**

The real party in interest is Harcourt Assessment, Inc., formerly known as The Psychological Corporation, San Antonio, TX, pursuant to the filing of an Assignment that was recorded on July 31, 1997, Reel/Frame 8737/0031.

II. **Related Appeals and Interferences**

No related Appeals or Interferences are known to Appellants, the undersigned, or the Assignee of the present case.

III. **Status of Claims**

On August 2, 2005, Appellants presented a Notice of Appeal from the final rejection of the claims under 35 U.S.C. §§102(e) and 103(a). Claims 1-25 are pending, are all under final rejection, and are hereby appealed. A copy of the claims as they exist in the case at present are attached as Appendix A.

IV. **Status of Amendments**

There is no pending amendment that has been filed since the mailing of the final Office Action on May 4, 2005.

V. Summary of Claimed Subject Matter

As recited in Claim 1, the invention is directed to a "method for scoring an answer page containing an answer to an open-ended question" [support in Specification p 11, lines 8-10; p 14, line 20- p 15, line 7; p 16, line 1 - p 18, line 18; in the drawing at FIGS. 6, 7A, and 7B].

The method comprises the step of viewing a first visual image [p. 16, lines 20-21; FIG. 7A] of a first portion of an answer page [51, FIG. 1; step 980, FIG. 6]. The first portion comprises an answer space [73, FIG. 7A] in which an answer to an open-ended question [71, FIG. 7A] is expected to reside. If the first portion of the answer page contains a complete answer [page 17, lines 16-17; step 987, FIG. 6], the answer is electronically scored [page 17, line 17; step 960, FIG. 6]. If the first portion of the answer page does not encompass a complete answer [page 17, lines 16-17; step 987, FIG. 6], a second visual image [FIG. 7B] of a second portion of the answer page is accessed and viewed [page 17, lines 17-19; step 988, FIG. 6], wherein the second portion comprises a sector of the answer page outside the answer space. Then the answer is electronically scored [step 960, FIG. 6].

Claim 17, the second independent claim, is directed to a "method for delivering an answer page containing an answer to an open-ended question to a reader for scoring" [support in Specification p 11, lines 8-10; p 14, line 15 - p 15, line 7; p 16, line 1 - p 18, line 18; in the drawing at FIGS. 5, 7A, and 7B].

The method comprises the step of retrieving from a storage device a visual image of an answer page that contains an answer to an open-ended question [page 14, lines 15-

16; FIG. 5, step 957]. A first display screen is formatted that comprises a first visual image of a first portion of an answer page [page 14, line 16; FIG. 5, step 958; FIG. 7A]. The first portion of the answer page comprises an answer space [73, FIG. 7A] in which an answer to an open-ended question is expected to reside. The first display screen is transmitted to a reader display device [page 14, lines 21-22; 51, FIG. 1], and the reader is permitted visual access on the display device to a second portion of the answer page at least partially outside the first portion [page 15, lines 1-4; FIG. 6, steps 987, 988].

No means- or step-plus-function language as permitted by 35 USC 112, sixth paragraph, is present in either of the independent claims, nor in any of the dependent claims to be argued separately.

VI. Grounds of Rejection to be Reviewed on Appeal

In a Final Office Action on the merits, dated May 4, 2005, Paper No./Mail Date 20050501, the Examiner rejected, under 35 USC §102(e): Claims 1-8, 13, 14, and 17-25 as being anticipated by Poor (US 5,672,060); under 35 USC §103(a): Claims 9, 15, and 16 as being unpatentable over Poor '060 in view of Clark et al. (US 5,321,611); Claim 10, over Poor '060 in view of Walker (US 6,093,026); Claim 11, over Poor '060 in view of Martinez (US 5,211,564); and Claim 12, over Poor '060/Martinez in view of Bier et al. (US 5,581,670).

VII. Argument

The claims of the case are grouped as follows for the subsequent discussion: Group I, Claims 1-6, 8, 13, 14, 17-23, and 25; Group II, Claims 7 and 24; Group III, Claim 9; Group IV, Claims 15, and 16; Group V, Claim 10; Group VI, Claim 11; Group VII, Claim 12.

1. Group I

Claims 1-6, 8, 13, 14, 17-23, and 25 have been rejected under 35 USC §102(e) as being anticipated by Poor (US 5,672,060).

This rejection is respectfully traversed. Independent Claims 1 and 17 will be discussed first. Both Claims 1 and 17 include recitations directed to portions of the answer page, wherein a first portion contains "an answer space in which an answer to an open-ended question is expected to reside". Claim 1 further contains the recitation of a step wherein, "if the first portion of the answer page does not encompass a complete answer, accessing and viewing a second visual image of a second portion of the answer page, the second portion comprising a sector of the answer page outside the answer space". Claim 17 further contains the recitation of a step of "permitting reader visual access on the display device to a second portion of the answer page at least partially outside the first portion."

The Examiner references Poor '060 at column 9, lines 6-12, which reads: "Whenever possible, the capture process should be set up so that the full width of the assessment material's image can be viewed on the screen at one time. If the length of the image exceeds the vertical display capability of the computer monitor, a method is

desirably included to smoothly 'scroll' the image up and down on the screen so that the entire image can be easily viewed by the scorer."

However, earlier in Poor, the definition of "the assessment material's image" is clearly delineated: "In the scoring of nonobjective assessment materials, OMR can be used to detect marks in areas designated for recording the assessment materials, assessment areas." [col. 5, lines 45-47] "By applying image capture processes to only the portion of the assessment are [sic, area] in which marks are detected, the process runs faster and consumes less file storage space." [col. 5, lines 55-57] "First, the scanner would be used to scan the assessment portion of the document . . ." [col 7, lines 3-4] "[F]or each respondent document scanned, a new captured image will be placed in the Image-Base file 10 whenever marks are detected in the assessment area. FIG. 5 shows a completed handwritten essay 22 in Assessment Area 7'." [col. 7, line 66 - col. 8, line 3] Please also note the instructions reproduced in FIG. 5: "BE SURE TO KEEP YOUR WRITTEN ESSAY WITHIN THE RED BORDER."

Clearly, therefore, Poor teaches the capture of an image within a predefined region of a page *at the most*, and that areas outside that region are *not* captured. Poor thus teaches away from the invention as claimed in Claims 1 and 17, which recite an ability to access portions of an image that lie outside the "answer space in which an answer to an open-ended question is expected to reside".

In context, then, the scrolling referred to in the cited portion of Poor refers to scrolling along the captured image on a computer monitor, the captured image comprising that assessment area referred to earlier in the patent, not in a region outside the assessment area.

MPEP §706.02(a) reads: "for anticipation under 35 U.S.C. 102, the reference must teach *every aspect of the claimed invention either explicitly or impliedly*. Any feature not directly taught must be inherently present." [emph. added] Further MPEP §2131 states that "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the . . . claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)."

It is respectfully asserted that the Examiner has not met her burden of demonstrating the presence of "every aspect of the claimed invention", and that, therefore, there is no anticipation of Claims 1 and 17 under 35 USC §102(e). Further, therefore, there can be no anticipation of Claims 2-8, 13, 14, and 18-25, dependent from Claims 1 and 17, by Poor '060.

2. Group II

Claims 7 and 24 have been rejected under 35 USC §102(e) as being anticipated by Poor (US 5,672,060).

This rejection is respectfully traversed.

Claim 7 recites the step of, "if the entire answer page does not encompass a complete answer, viewing a first visual image of a second answer page to search for a complete answer." The Examiner considers, on page 4 of the Office Action of May 4, 2004, that "[t]he part of the screen in Poor wherein the user views the completion of answer

by scrolling in Poor is considered by Examiner to be a second answer page." However, in the Poor '060 Specification, there is no teaching or suggestion, as stated above, to capture a visual image outside the expected answer sector; there is even less of a suggestion in Poor '060 to proceed yet further onto another visually imaged answer page entirely to "search for a complete answer."

Claim 24 recites the step of, "if the answer page does not encompass a complete answer, repeating the retrieving, formatting, transmitting, and permitting steps on a second answer page." Similarly as for Claim 7, as Poor '060 neither teaches nor suggests capturing and providing a visual image to a scorer that resides outside an answer sector, there is no teaching or suggestion to image and then make available to the scorer a formatted visual image of a second answer page for scoring.

Therefore, it is respectfully believed that Claims 7 and 24 are not anticipated by Poor '060, and that Claims 7 and 24 patentably define thereover.

3. Group III

Claim 9 has been rejected under 35 USC §103(a) as being unpatentable over Poor '060 in view of Clark et al. (US 5,321,611).

This rejection is respectfully traversed. Claim 9 recites the additional step of: "if a question occurs during the scoring step, electronically transmitting a query to a supervisor." The Examiner relies on Clark '611 to supply this step. However, first, Clark '611 does not supply this step. The cited text of Clark reads: "If the first two resolvers scores do not need to agree, then the *system* preferably transmits the test item to a third resolver to 'cure' the discrepancy in the first two scores." [col. 7, lines 38-41] Therefore, there is in fact no

teaching to “[transmit] a query to a supervisor” as recited in present Claim 9. The Clark disclosure is directed to “collaborative scoring”, wherein two or more equal-level resolvers work together to formulate a score for a single test item, which is not analogous to the open-ended scoring being recited in the present case.

Second, as found in *In re Wesslau*, 353 F.2d at 241, 147 USPQ at 393 (CCPA 1965), “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1784 (Fed. Cir. 1992) tells us that “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. . . . The court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’”

In addition, *In re Kotzab*, 208 F.3d 1365, 1370, 34 USPQ2d 1308, 1316 (Fed. Cir. 2000) states that, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.” *In re Dembiczak*, 175 F.3d at 999, 50 USPQ 2d at 1617 (Fed. Cir. 1999) states that “to reject an inventor’s claim for obviousness in view of a combination of prior art references, a showing of a suggestion, teaching, or motivation must be “clear and particular.”

There is no motivation, suggestion, or teaching in the applied references to combine the elements of the cited art to arrive at the specific combination recited in Claim 9, and, therefore, Claim 9 patentably defines over the cited art.

4. Group IV

Claims 15 and 16 have been rejected under 35 USC §103(a) as being unpatentable over Poor '060 in view of Clark et al. (US 5,321,611).

This rejection is respectfully traversed. Claim 15 recites the additional steps of "calculating a time span between the first visual image viewing step and the scoring step, and comparing the time span with a target scoring time." Claim 16 recites the additional step of "calculating a reader efficiency from the time-span comparing step."

The Examiner relies on Clark '611 to supply these steps, which are admitted as not being taught by Poor '060. Since, there is no "second visual image" taught by either Poor or Clark, the additional steps as recited in Claims 15 and 16 serve to further define thereover.

Claims 15 and 16 are therefore believed free of the cited art.

5. Group V

Claim 10 has been rejected under 35 USC §103(a) as being unpatentable over Poor '060 in view of Walker (US 6,093,026).

This rejection is respectfully traversed. Claim 10 recites that "the answer comprises an answer in verbal form." Respectfully, the Examiner has misunderstood the meaning of

"verbal," which here is intended to mean in the form of words, not spoken, which properly is denoted as "oral." The word "verbal" can mean either written or spoken verbiage.

Therefore, the rejection in view of Walker is inappropriate, and Claim 10 is believed free of the cited art.

6. Group VI

Claim 11 has been rejected under 35 USC §103(a) as being unpatentable over Poor '060 in view of Martinez (US 5,211,564).

This rejection is respectfully traversed. Claim 11 recites that "the answer comprises a geometric diagram." Martinez '564 in the cited portion refers to the use by the examinee of a geometric tool. There is no teaching in Martinez to supply a human scorer with a geometric tool for making measurements of a visual image.

Therefore, Claim 11 patentably defines over the cited art.

7. Group VII

Claim 12 has been rejected under 35 USC §103(a) as being unpatentable over Poor '060/Martinez in view of Bier et al. (US 5,581,670).

This rejection is respectfully traversed. Claim 12 recites the step of "accessing an electronically manipulable display of a geometric tool for assessing the geometric diagram." As stated above, Martinez does not teach the use by a human scorer of a geometric tool to measure a visual image. Bier '670 is not directed to scoring assessments. Therefore, the recited step is neither taught nor suggested by the cited art, alone or taken in combination.

Thus Claim 12 patentably distinguishes over the cited art.

Appellant has presented arguments against the appropriateness of the Examiner's use of 35 USC §§102(e) and 103(a) to reject Claims 1-25.

It is thus respectfully requested that the decision of the Examiner be reversed.

Respectfully submitted,



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Appendix A - Claims in the Case - Application Number 10/765,749

1. A method for scoring an answer page containing an answer to an open-ended question, the method comprising the steps of:

viewing a first visual image of a first portion of an answer page, the first portion comprising an answer space in which an answer to an open-ended question is expected to reside;

if the first portion of the answer page contains a complete answer, electronically scoring the answer;

if the first portion of the answer page does not encompass a complete answer, accessing and viewing a second visual image of a second portion of the answer page, the second portion comprising a sector of the answer page outside the answer space, and electronically scoring the answer.

2. The method recited in Claim 1, wherein the viewing step comprises receiving the first and the second visual image through a processor onto a display device.

3. The method recited in Claim 1, further comprising the steps of:
entering an electronic scoring system;
requesting to view an answer to score; and
receiving the first visual image from a queue comprising a plurality of answer page images.

4. The method recited in Claim 1, wherein the electronically scoring step comprises selecting a numerical score for the answer from a score sector on a display.

5. The method recited in Claim 4, wherein the score sector comprises a score button bar displayed on a common display with the first visual image.

6. The method recited in Claim 1, further comprising the steps, if the first and the second visual image do not encompass a complete answer, of repeating the accessing and viewing steps until substantially the entire answer page is viewed.

7. The method recited in Claim 6, wherein, if the entire answer page does not encompass a complete answer, viewing a first visual image of a second answer page to search for a complete answer.

8. The method recited in Claim 1, wherein the viewing steps comprise receiving the first and the second visual image through a processor onto a display device, and the accessing step comprises electronically manipulating a scroll bar on the display device.

9. The method recited in Claim 1, further comprising the step of, if a question occurs during the scoring step, electronically transmitting a query to a supervisor.

10. The method recited in Claim 1, wherein the answer comprises an answer in verbal form.

11. The method recited in Claim 1, wherein the answer comprises a geometric diagram.

12. The method recited in Claim 11, further comprising the step of accessing an electronically manipulable display of a geometric tool for assessing the geometric diagram.

13. The method recited in Claim 1, wherein the answer comprises a calibration answer, and further comprising the steps of receiving a score and comparing the received score with a target score.

14. The method recited in Claim 13, further comprising the step of calculating a reader effectiveness from the comparing step.

15. The method recited in Claim 13, further comprising the steps of calculating a time span between the first visual image viewing step and the scoring step, and comparing the time span with a target scoring time.

16. The method recited in Claim 15, further comprising the step of calculating a reader efficiency from the time-span comparing step.

17. A method for delivering an answer page containing an answer to an open-ended question to a reader for scoring, the method comprising the steps of:

retrieving from a storage device a visual image of an answer page containing an answer to an open-ended question;

formatting a first display screen comprising a first visual image of a first portion of an answer page, the first portion comprising an answer space in which an answer to an open-ended question is expected to reside;

transmitting to a reader display device the first display screen; and

permitting reader visual access on the display device to a second portion of the answer page at least partially outside the first portion.

18. The method recited in Claim 17, wherein the retrieving step comprises the steps of:

determining a batch comprising a plurality of answers to be scored, the plurality of answers comprising answers to a unitary test question;

fetching answer page images corresponding to the determined batch from a storage device; and

holding the fetched answer page images in a cache.

19. The method recited in Claim 18, further comprising the steps, prior to the formatting and transmitting steps, of retrieving a scoring and a display protocol for answers to the test question.

20. The method recited in Claim 19, wherein the scoring protocol comprises a numerical score range for answers to the test question.

21. The method recited in Claim 20, wherein the first visual image comprises a score selection element, and the formatting step comprises including the score selection element as dictated by the display protocol.

22. The method recited in Claim 21, wherein the score selection element comprises a score button bar.

23. The method recited in Claim 17, wherein the first display screen further comprises a score selection element.

24. The method recited in Claim 17, wherein, if the answer page does not encompass a complete answer, repeating the retrieving, formatting, transmitting, and permitting steps on a second answer page.

25. The method recited in Claim 17, wherein the first display screen further comprises an electronically manipulable scroll bar, and wherein the permitting step comprises receiving a signal indicative of a manipulation of the scroll bar and transmitting to the reader display device a second display screen comprising the second portion of the answer page corresponding to the signal.

Appendix B - Evidence Appendix - Application Number 10/765,749

There are no documents of record in the present case that have been submitted pursuant to 37 CFR §§1.130, 1.131, or 1.132 pursuant to §41.37(c)(1)(ix).

Appendix C - Related Proceedings - Application Number 10/765,749

There are no related proceedings to the present case, as indicated above pursuant to paragraph (c)(1)(ii).